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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/733,746

12/11/2003

Mary Jo Kilburn

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04/02/2008

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EXAMINER

GORT, ELAINE L

ART UNIT

PAPER NUMBER

3687

NOTIFICATION DATE

DELIVERY MODE

04/02/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/733,746	<b>Applicant(s)</b> KILBURN ET AL.	
	<b>Examiner</b> Elaine Gort	<b>Art Unit</b> 3687	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-27 is/are pending in the application.
- 4a) Of the above claim(s) 14-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-13 and 24-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 14-23 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 5/9/07.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 recites the limitation "the product contents" in line 2. There is insufficient antecedent basis for this limitation in the claim. For purposes of this action it is assumed what is meant is "the products".

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**5. Claims 1, 6, 8, 9 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Ananian et al. (US Patent 6,922,701).**

Ananian et al. discloses the claimed portable system comprising a host system, and a field system that can communicate with the host system, the portable system capable of:

receiving engineering information related to at least a portion of a construction project from a database or spreadsheet (see database 40), formatting the information into a suitable format to be used for one or more of printing identification product, preparing work packages, tracking materials used, and reporting materials used for the construction project (the system of Ananian receives plan sets submitted by the client, column 2, lines 43+, which Examiner construes to be “engineering information”, formats the information into a format for the claimed uses when the plan set is converted to a profile data set by the profiling engine, column 2, line 62+. Column 9 line 19 discusses the use of id tags on every component.); generating orders for identification products and managing fulfillment of the orders (Column 9 lines 9+ and column 19 lines 9+ disclose where every item ordered is uniquely identified with a unique identifier to manage the order and items. Examiner construes that these tags are “identification products” and in order for them to be assigned they are ordered. Examiner further notes that column 8 lines 54+; column 17, lines 27+; and column 17 lines 6+ discuss the ordering and procurement of everything needed to complete a project.);

(regarding claim 6) printers are widely accepted and are presumed inherent in the system of Ananian to provide user to obtain hard copies of data, labels or reports;

(regarding claims 8 and 9) where a portion of the project is an electrical subproject and the label or marker is for an electrical device, cable or termination (see for example column 14 table 1 disclosing the items with identifiers including electrical components, such as wall outlets, switches, fuse boxes, etc...); and

(regarding claim 13) generating reports for cable length requirements and actual length of cable used (system calculates required amounts of materials, for example see last sentence of abstract, which includes electrical components for buildings which inherently includes cable lengths necessary for wiring the buildings).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**7. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ananian et al. (US Patent 6,922,701) in view of Barry et al. (US Patent 7,225,249).**

Ananian et al. discloses the claimed device but is silent regarding generating a termination report. Barry et al. discloses that it is known in the art to provide termination reports in order to report important information, see paragraph (265). It would have

been obvious to one having ordinary skill in the art at the time the invention was made to provide the system of Ananian et al. with the termination reports of Barry et al., in order to report important information.

**8. Claims 4, 7, 11, 12 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ananian et al. (US Patent 6,922,701) in view of Kendall et al. (US Patent 6,508,900).**

Ananian et al. discloses the claimed device but is silent regarding generating pull cards, formatting of printed labels and the delivery of items as a kit. Kendall et al. discloses that it is known in the art to provide items/containers of items with pull cards in order to provide additional information and/or instructions for proper use (see column 1 lines 63+) to have formatted printed labels for items (Kennedy label inherently has text on it which is formatted, column 2) to have legible labels, and to deliver items as a group, or kit (column 1 lines 63+) to keep associated items together. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system of Ananian et al. with the pull cards, formatting of printed labels and the delivery of items as a kit as taught by Kendall et al., in order to provide additional information and/or instructions for proper use with the items, to have legible labels and to keep associated items together.

Regarding pre-selected level criteria for the products, these pre-selected levels include for example, criteria such as the disclosed electrical covers or door hinges with

exact location and area within a building that it is to be used or was used disclosed in column 9 lines 7+.

**9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ananian et al. (US Patent 6,922,701) in view of Birkner et al. (Pub No US 2002/0198755 A1).**

Ananian et al. discloses the claimed device but is silent regarding tracking of project progress measured by materials used and man-hours used. Birkner et al. discloses that it is known in the art to track material consumption and man hours used to track materials and man hour usage in relation to progress of the project, see abstract and paragraph [0009]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the system of Ananian et al. with the tracking of progress by materials used and man-hours used of Birkner et al., in order to track materials and man hours in relation to project progress.

***Response to Arguments***

10. Applicant's arguments filed 1/11/08 have been fully considered but they are not persuasive.

Applicant argues that the terms "the product contents" claimed in claim 12 line 3 has clear antecedent basis. Examiner contends that there is no reference to a product content prior to the claiming of "the product contents" and therefore remains indefinite

for failing to particularly point and distinctly claiming the subject matter which applicant regards as the invention.

Examiner appreciates Applicant's reference to clarify the terms regarding "level criteria".

Applicant argues that Ananian does not disclose ordering and order fulfillment of required products being managed and accomplished.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., ordering of required products) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examiner notes that the claim discusses "identification product/s" in lines 5 and 7, but does not claim "required products". The scope of the claim, broadly construed reads on the ordering, printing and managing of the identification tags of products only and does not necessarily encompass ordering of the product the tag goes on. Examiner notes however that Ananian discloses the ordering of products in addition to having unique id tags on every product/component in column 8 lines 60-62 where it discusses ordering via external databases such as a furnishing database 102.

Applicant further argues that Ananian does not disclose capability to generate product orders or manage order fulfillment. Examiner contends that Ananian discloses the capability to generate product orders for identification products and manages order



fulfillment when it assigns to and tracks unique id descriptor tags for every component part of a building thru construction.

Additionally Ananian discloses generating orders for products, such as furniture, fixtures or a specific door's trim, and managing order fulfillment of these products all the way until the product is installed, such as the trim is installed into the home, for example see column 19 lines 9+.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is 571/272-6781. The examiner can normally be reached on Monday and Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gort Matthew can be reached on 571/272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elaine Gort/  
Primary Examiner, Art Unit 3687

Elaine Gort  
Primary Examiner  
Art Unit 3687

3/26/2008